

REMARKS

Claims 1-14 are now pending in this application. Claim 1 is rejected. New claims 2-14 are added. Claim 1 is amended herein to address matters of form unrelated to substantive patentability issues.

Applicant herein traverses and respectfully requests reconsideration of the rejection of the claims cited in the above-referenced Office Action.

The Office Action indicates that a substitute specification in proper idiomatic English is required. Applicant submits herewith a substitute specification and abstract wherein amendments are effected to place the text thereof into proper English in accordance with 37 CFR 1.125(c). Also accompanying this amendment is a reproduction of the original specification and abstract with markings indicating the amendments effected in the substitute specification and abstract in accordance with MPEP §608.01(q) and 37 CFR 1.125(b). No new matter is added. Entry of the substitute specification and abstract is respectfully requested.

Claim 1 is rejected under 35 U.S.C. § 112, first paragraph, for containing subject matter lacking an adequate written description in the specification. Applicant herein respectfully traverses this rejection.

The description requirement of the first paragraph of 35 U.S.C. § 112 functions to ensure that the inventor had possession of the subject matter later claimed. How the specification satisfies this requirement is immaterial. It is not

necessary that the application describe every claim exactly, but only so much that persons of ordinary skill in the art will recognize from the disclosure that the applicant invented the subject matter with the claimed limitations. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90, 96 (CCPA 1976). In other words, the claimed subject matter need not be described in *haec verba* in the specification in order for the specification to satisfy the description requirement. *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989). Therefore, a determination of fulfillment of the description requirement under § 112, first paragraph, turns on whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986).

The written description requirement of 35 U.S.C. § 112, first paragraph is generally only invoked when new claims not originally presented are added by amendment, since they could then potentially be of a scope beyond that which is described in the specification disclosure. Since claim 1 is an originally filed claim, finding full support for the language used therein, for example, at page 4, first full paragraph, applicant respectfully submits that the Examiner is misapplying a rejection based on written description. For this reason, applicant believes that the Examiner has intended to apply an enablement rejection under 35 U.S.C. § 112, first paragraph, alleging that one skilled in the art could not practice the claimed invention without undue experimentation. This assumption

notwithstanding, applicant respectfully submits that one of ordinary skill in the art would be readily able to practice the invention as claimed, and that claim 1 is similarly fully enabled by the disclosure.

One skilled in the art is fully familiar with various available fabrics and the like which possess physical characteristics which would be suitable for use in implementing the claimed invention. This knowledge is exemplified quite clearly by specific reference in the instant specification to "a taping tape wherein the whole of the cloth or the similar material is made of the same raw material and in the same weaving manner, and thus all the area of the taping tape has an even degree of shrinkage," reference being made to an example disclosed in a Japanese Patent Application. (see paragraph bridging pages 2 and 3). Therefore, it is apparent that one skilled in the art would be able to select a fabric with a desired degree of shrinkage and one with a lesser degree of shrinkage for use in a different region of the claimed body sticking sheet very easily.

MPEP 2164.01 sets forth the test of enablement, stating that "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480

U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).
(emphasis added).

It is the Examiner's expressed position that the claimed product is described merely in functional terms. The conclusion is then drawn that "applicant has not shown to be in possession of the full scope of the claimed invention." Applicant respectfully submits that this analysis is flawed in that the claims are recited in terms of very specific physical characteristics, including a degree of stretchability. Surely claiming that a material has elastic (shrinkable) characteristics is not functional, but rather purely physical.

Applicant is aware of no requirement that the subject matter of a claim be limited to specific materials, so long as the language describes the metes and bounds of the intended claimed subject matter. In the present instance, it is applicant's desire to claim the invention as embracing any and all suitable sheets having the claimed physical characteristics of greater or lesser elasticity in different regions. Since these characteristics and their respective relative placement in the sheet are fully supported by the disclosure as originally filed, including original claim 1, applicant respectfully submits that claim 1 avoids rejection under 35 U.S.C. § 112, first paragraph, for containing subject matter lacking an adequate written description in the specification and lack of enabling

disclosure. Therefore, reconsideration of the rejection and allowance of claim 1 are earnestly solicited.

Claim 1 is rejected as indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter of the invention as a result of an informality stated in the Office Action. The claim is amended to remove or correct the informality noted in the Office Action. In particular, claim 1 now directly interrelates the degrees of shrinkage in the two regions, rather than by use of the alleged relative terms "small" and "large." Therefore, reconsideration of the rejection of the claim and its allowance are earnestly requested.

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Gordon (US 3,329,143). Applicant herein respectfully traverses this rejection. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" ***Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.***, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). It is respectfully submitted that the cited reference is deficient with regard to the following.

Claim 1 is amended, and recites in pertinent part the following:

a first portion having a first degree of shrinkage contactably receivable to the affected area; and

a second portion including a second degree of shrinkage contactably receivable to a portion of the body region surrounding the first portion, said second degree of shrinkage being 2 to 20 times greater than said first degree of shrinkage, said second portion being expandable and contractible radially with centering on the first portion

Applicant respectfully submits that the Gordan reference fails to teach or suggest such features. For example, the shrinkable plastic bandage cover (being read on the claimed “second portion”) is not expandable and contractible radially with centering on the bandage (being read on the “first portion”), nor is it “contactably receivable to a portion of the body region surrounding the first portion.”

Claim 1 particularly describes and distinctly claims at least one element not disclosed in the cited reference. Therefore, reconsideration of the rejection of claim 1 and its allowance are respectfully requested.

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by JP 6339495 (JP '495). Applicant herein respectfully traverses this rejection.

Applicant respectfully submits that the cited reference fails to disclose “said second degree of shrinkage [of the support member] being 2 to 20 times greater than said first degree of shrinkage [of the gauze].”

Claim 1 particularly describes and distinctly claims at least one element not disclosed in the cited reference. Therefore, reconsideration of the rejection of claim 1 and its allowance are respectfully requested.

Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by Liguori (US Pub. 2003/0023197). Applicant herein respectfully traverses this rejection.

Like JP '495, the sheet strip 12 (compared with the first portion) is not disclosed as having degree of shrinkage which is 2 to 20 times greater than that of the gauze or padding 20.

Claim 1 particularly describes and distinctly claims at least one element not disclosed in the cited reference. Therefore, reconsideration of the rejection of claim 1 and its allowance are respectfully requested.

Claims 2-14 are added and are submitted as patentable over the cited art of record. Independent claim 8 recites subject matter directed to a first portion comprised of a material including a first degree of elasticity, a second portion comprised of another material including a second degree of elasticity greater than

said first degree of elasticity, and an adhesive being disposed on a contact side of the first and second portions which, among other features recited therein, is not believed disclosed in the cited art in the manner as claimed. Dependent claims 2-7 and 9-14 are patentable based on the subject matter recited therein in addition to the subject matter of claims 1 and 8.

Applicant respectfully requests a one (1) three month extension of time for responding to the Office Action. Please charge the fee of \$130 for the extension of time to Deposit Account No. 10-1250.

The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,

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